

REMARKS/ARGUMENTS

By the foregoing amendment applicant has cancelled claims 4 and 10-14 and added to claim 1 the subject matter of prior claim 4 requiring the first adhesive to include about 2-10% by weight shredded fiberglass. The dependencies of claims 5 and 6 have been changed to claim 1 and claims 10-14 are cancelled since they would otherwise be redundant. This leaves for further consideration claims 1-3, 5-9 and 15-16.

The rejection of claim 1 (previously claim 4) as unpatentable over Murphy U.S. patent No. 5,601,910 in view of Kreckel U.S. patent No. 5,536,778 and/or Kojima U.S. patent No. 5,852,119 is respectfully traversed. The present invention enables installation of fresh commercial carpet over removable material forming part of the flooring system such that the commercial carpet and removable material may be subsequently removed and fresh commercial carpet and removable material may be installed. To accomplish that, a first pressure sensitive adhesive is applied to a first flooring surface which may be wood tile or carpet tile. The pressure-sensitive adhesive includes about 2-10% by weight shredded fiberglass to enhance the strength of the adhesive when applied as a bond between the flooring surface and the layer of non-woven material. The layer of non-woven material provides a macroscopically smooth clean surface substantially impervious to moisture. Commercial carpeting, e.g., wall-to-wall broadloom is then applied to the layer of non-woven material by first applying a second layer of wet-laid adhesive directly to the non-woven layer. After the new broadloom carpeting is applied, it will be appreciated that the entire carpeting system, i.e. broadloom carpeting, second layer of wet-laid adhesive, the non-woven layer, and the first pressure sensitive adhesive with shredded fiberglass can be readily subsequently removed from the flooring surface which can then be recarpeted. Additionally, the non-woven is provided with weft directed reinforcing threads which enhance the tear strength of the intermediate underlayment.

In Murphy, there is provided a needle punched underlayment adhered to a sub floor. An area rug is then adhered to the upper surface of the underlayment. At column 5, lines 40 et seq Murphy appears to disclose pressure-sensitive adhesive applied to both sides of the mat (underlayment) with overlying release paper on both side. The Examiner acknowledges Murphy does not teach an adhesive having shredded fiberglass filler (claim 1) or a latex adhesive (claim 6). Murphy is also deficient in disclosing a wet-laid adhesive (claim 3) which is a permanent

type adhesive for permanently securing the carpeting to the layer of non-woven material. The Examiner indicates that such deficiencies as between the disclosure in Murphy and the claimed subject matter are found in either one or both of Kreckel and Kojima.

In both references, glass fibers are disclosed as part of pressure-sensitive adhesives. The Examiner concludes the obviousness of applying such glass fiber filler in pressure-sensitive adhesives to the pressure-sensitive adhesive used in Murphy between the underlayment and the floor surface predicated on the legal conclusion on the stated conjecture that it might be desirable to decrease the amount of PSA employed or to improve the moisture resistance of the PSA. While it is true that PSA may have glass fibers as a constituent as in Kreckel or Kojima, viewing the references without applicant's disclosure or claims does not suggest or teach the use of shredded fiberglass as an adhesive to secure a non-woven material to an underlying floor surface. *In re Rouffet*, 47 USPQ 2d 1453 (Fed. Cir. 1998) is instructive on this point;

[v]irtually all [inventions] are combinations of old elements. ... ("Most, if not all, inventions are combinations and mostly of old elements"). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Further, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as the blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." (citation omitted)

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this Court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the invention and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In short, without applicant's teaching, the references *per se* do not teach the claimed invention. The mere existence of PSA with fiberglass in the prior art is not sufficient as

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motivation for the alleged obvious combination of references. Moreover, the references do not teach the wet-laid adhesive of claim 3 or the actual constituency of the required 5-7% shredded fiberglass set forth in claim 5. Also, there is no teaching for a latex adhesive as the first adhesive in the context of the presently claimed invention in the applied prior art. Applicant submits the Examiner is combining the references in a manner taught by applicant and not by the prior art.

The rejection of claims 15 and 16 is unpatentable over Murphy in view of U.S. patent No. 4,976,118 to Tough is respectfully traversed. Obviously this combination does not include the first PSA having shredded fiberglass. As noted previously the weft extending threads substantially reinforce the layer of non-woven material to provide a more secure underlayment for the carpeting installation. Applicant submits therefore that the combination of Tough and Murphy is not suggested from the mere existence in the prior art of the claimed aspects, is not taught by the references themselves, in any event lacks the shredded fiberglass in the first PSA and would not have been suggested in the context of the presently claimed invention.

Accordingly, reconsideration and allowance of the claims presently pending in the application is respectfully requested.

Respectfully submitted,

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